

REMARKS

Applicant respectfully requests reconsideration and allowance of all of the claims of the application. The status of the claims is as follows:

- Claims 1-38 are currently pending.
- Claims 1, 25, 27, 37, and 38 are currently amended.
- No new claims are added, cancelled or withdrawn.

Support for the amendment to claim 1 is found in the specification at least at ¶ [0028]. Support for the amendment to claim 38 is found in the specification at least at ¶ [0017].

Rejections under § 112, 2nd Paragraph

Claims 1-13 stand rejected under 35 U.S.C. § 112, Paragraph 2, as allegedly being indefinite. Applicant respectfully traverses this rejection.

Nevertheless, for the sole purpose of advancing prosecution and without commenting on the propriety of the Office's rejections, Applicant herein amends claim 1 as shown above. Claims 2-13 depend from claim 1. Applicant respectfully submits that this amendment renders the § 112, Paragraph 2, rejections of claims 1-13 moot.

Claims 30-36 Recite Statutory Subject Matter Under § 101

Claims 30-36 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

In response to these rejections, Applicant expressly surrenders non-statutory propagating signals from the scope of any claims of this present Application. Since non-statutory propagating signals are no longer within the scope of the broadest reasonable interpretation of these claims, Applicant respectfully requests that the Office withdraw its § 101 rejections.

Within the past year, 35 U.S.C. § 101 rejections have arisen for software claims alleging that the preambles of the claims should recite “non-transitory” computer-readable media. While quite rare at first, it appears that these rejections are being issued more and more frequently due to a change in USPTO policy.

The term “non-transitory” appeared in a USPTO training material at least as early as August 25, 2009 (see USPTO 101 Training Materials, particularly slides 4 and 10). In slide 4, the USPTO lists “transitory signals per se” as subject matter that is not patent-eligible. Slide 10 further states that a “non-transitory computer-readable storage medium” is an article of manufacture.

Further, in a memo dated January 26, 2010, Director Kappos stated that [with emphasis added]:

The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a **signal per se**, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. See *In re Nujiten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101, Aug. 24, 2009, p. 2.

While the statements allude to forms of non-transitory storage media other than a signal, such media are not specifically listed. Accordingly, it appears that Director Kappos only intended to remove signals from the scope of the claims. The memo recommends amending the claims to recite “non-transitory” storage media since such an amendment will typically not raise the issue of new matter. However, amending the claims or specification to recite that the computer-readable media are “non-transitory” alone may leave the application open to later mischief during claim construction.

Rather than amend the claims, Applicant instead expressly surrenders non-statutory propagating signals from the scope of any claims of this present Application. Accordingly, Applicant asks the Office to withdraw the § 101 rejections.

Cited Documents

The following documents have been applied to reject one or more claims of the Application:

- **Heikes:** Heikes et al., U.S. Patent Application Publication No. 2003/0225847
- **Danker:** Danker et al., U.S. Patent Application Publication No. 2002/0184309
- **Chodor:** Chodor et al., U.S. Patent Application Publication No. 2002/0036990
- **Hickman:** Hickman et al., U.S. Patent No. 7,013,327
- **Dawson:** Dawson, U.S. Patent No. 6,252,588
- **Goodwin:** Goodwin, III et al., U.S. Patent Application Publication No. 2002/0065931
- **Goldschneider:** Goldschneider et al., U.S. Patent Application Publication No. 2002/017925

- **Huntington:** Huntington et al., U.S. Patent Application Publication No. 2003/0131098
- **Zhao:** Zhao, U.S. Patent No. 7,353,253
- **Official Notice:** Official Notice (see MPEP 2144.03)

§ 103 Rejections

Claims 1-4, 6-7, 11-14, 17, 21, 23-25, 30-31, 33 and 35-36 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Heikes in view of Danker.

Claims 5, 26, 28-29 and 32 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Heikes in view of Danker, as applied to claim 1, and further in view of Chodor.

Claims 8-10, 15-16, 27 and 34 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Heikes in view of Danker and Chodor, as applied to claims 5, 26, 28, 29 and 32, and further in view of Hickman.

Claims 8-10, 15, 16, 27 and 34 also stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Heikes in view of Danker and Chodor, as applied to claims 5, 26, 28-29 and 32, and further in view of Dawson.

Claim 18 stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Heikes in view of Danker, as applied to claim 1, and further in view of Goodwin.

Claim 19 stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Heikes in view of Danker, as applied to claim 1, and further in view of Goldschneider and Huntington.

Claim 20 stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Heikes in view of Danker, Goldschneider and Huntington, as applied to claim 19 above, and further in view of Zhao.

Applicant submits that the Office has failed to establish a *prima facie* case of obviousness, and in view of the comments below, respectfully traverses the Office's rejections.

The Claims

As amended, **claim 1** recites a method comprising [emphasis added]:

- selecting, by a user via a user-input device of a sender, a still image that includes a single array grid of pixels, wherein the still image is not part of an existing character set stored on the sender;
- **transforming, by a pixel array generator of the sender, the selected still image *into a custom graphical emoticon*;**
- obtaining a character sequence from the user via the user-input device of the sender;
- assigning the character sequence to the custom graphical emoticon, the character sequence representing the custom graphical emoticon, wherein the character sequence acts as a placeholder for the custom graphical emoticon;
- obtaining a message from the user via the user-input device of the sender, the message including textual content with the emoticon-placeholder character sequence embedded therein;
- transmitting the message from the sender to a destination via a message-transmission modality of transmission, the transmitted message including the textual content with the emoticon-placeholder character sequence embedded therein; and
- separately from the transmitting of the message, sending the custom graphical emoticon to the destination via a different modality of transmission than the message-transmission modality of transmission.

In making out the rejection of this claim, the Office argues that Heikes discloses “creating, by a pixel array generator of the sender, a custom graphical emoticon so that the still image is used as the custom graphical image.” Applicant respectfully disagrees.

In support of its argument, the Office cites Heikes’s Figure 7 along with paragraph [0060], lines 6-7, and paragraph [0068]. The cited textual portions, along with paragraphs [0058] and [0095] for context, are reproduced below for the Office’s convenience [emphasis added]:

[0058] The IM sender may have **selected** wallpaper from a location including the IM sender system 105, the IM host system 310, or another host system. When the IM sender **chooses** wallpaper that is locally stored on the IM sender system 105, an identifier may be created for the *chosen* wallpaper based upon a hash of the item data. The identifier, when sent to the a remote location such as the IM host 310, may be checked to determine if the chosen wallpaper is already known to the host system, and if so, whether the wallpaper is designated as, for example, an official item. This allows the IM sender to **select** wallpaper from the IM sender’s own client system, but prevents the host system or other remote location from needing to store duplicate copies of the same items. Also, the host system or other remote location is able to determine if such items are specially designated as, for example, official items and may be rendered to users who desire to view only items so designated.

[0060] Finally, the IM sender system 105 receives the selected wallpaper (step 535). The items may include information allowing the wallpaper to be rendered by the IM recipient system. For example, the wallpaper may include a type identifier that identifies the wallpaper as wallpaper. Also, the wallpaper may include one or more flags to indicate, for example, if the wallpaper is a custom item or an “official” item, has been banned, or has expired. The wallpaper may further include information concerning its size. The wallpaper may be in a predetermined format and may be of a predetermined length.

[0068] FIG. 8 illustrates an example of a UI 800 for enabling an IM sender to select smiley themes. The UI 800 is rendered in response to user manipulation of a control 620b (shown in FIG. 6). In the example of FIG. 8, the IM sender is presented with a list of smiley theme categories 805. When an IM sender selects a category 805, a window 810 displays the wallpaper available in the selected category. The IM sender may select wallpaper by, for example, using a mouse or other input device to make

the selection among the available items in the window 810. Also, an archive of old wallpaper may be provided for IM sender selection. In another implementation, the IM sender may **provide** a custom smiley theme.

[0095] In one implementation, the IM recipient and/or the IM sender **may pay a subscription fee** to access/use certain wallpaper, and the **wallpaper may be provided by a third party**. In another implementation, the wallpaper expire [sic] and must be replaced after a predetermined event such as a predetermined length of time, passage of a predetermined date, or a predetermined number of uses. Also, a wallpaper may be banned if, for example, it is deemed to be offensive, inappropriate, or to otherwise violate a term of service agreement. If it is determined that the wallpaper is expired or banned, display of such a wallpaper will be disallowed and the user typically will be required to choose a different wallpaper.

Applicant has thoroughly reviewed not only the cited portions reproduced above, but also the entire Heikes reference and can find no teaching or suggestion of “creating, by a pixel array generator of the sender, a custom graphical emoticon so that the still image is used as the custom graphical emoticon.” In detailing its argument, the Office seems to equate Heikes’s wallpaper with both Applicant’s “still image” and Applicant’s “custom graphical emoticon.” However, Applicant is unclear what aspect of Heikes’s system the Office equates with Applicant’s “pixel array generator of the sender.” Applicant respectfully submits that Heikes does not teach a “pixel array generator of the sender” for creating a custom graphical emoticon because Heike’s sender does not **create** wallpaper or emoticons. Rather, Heikes’s sender may **select** or **choose** wallpaper from the sender’s system. In paragraph [0095], Heikes teaches that the sender may pay a subscription fee to access such wallpaper and that the wallpaper might be provided by a third party. Selecting wallpaper provided by a third party is quite different from “**creating, by a pixel array generator of the sender**, a custom graphical emoticon from the selected still image.”

Nevertheless, for the sole purpose of expediting prosecution, Applicant has amended claim 1 to make the patentable distinction even more apparent. Claim 1 now reads, in part, “**transforming**, by a pixel array generator of the sender, the selected still image **into a custom graphical emoticon.**”

Applicant respectfully submits that neither Heikes nor Danker disclose or suggest the features of this claim in either its previously presented or currently amended state. If the Office insists on maintaining this rejection, the Office is respectfully requested to **specifically** point out where Heikes or Danker teaches a pixel array generator of the sender that would perform such a function.

Accordingly, for at least these reasons, this claim is allowable. Applicant respectfully requests that the Office withdraw the § 103 rejection of claim 1.

Claims 2-4, 6, 7 and 11-13 depend from independent claim 1. As discussed above, claim 1 is allowable over the cited documents. Therefore, claims 2-4, 6, 7 and 11-13 are also allowable over the cited documents of record for at least their dependency from an allowable base claim, and also for the additional features that each recites. Accordingly, Applicant respectfully requests that the Office withdraw the § 103 rejections of claims 2-4, 6, 7 and 11-13.

Claim 5 depends from independent claim 1. As discussed above, claim 1 is allowable over the combination of Heikes and Danker. Chodor is cited for its alleged teaching of parsing the character sequence into an object name for the custom graphical emoticon set. However, Chodor fails to remedy the deficiencies of Heikes and Danker, as noted above with regard to independent claim 1. Therefore, claim 5 is also allowable over the cited documents of record for at least its dependency from an

allowable base claim, and also for the additional features that it recites. Accordingly, Applicant respectfully requests that the Office withdraw the § 103 rejection of claim 5.

Claims 8-10 ultimately depend from independent claim 1. As discussed above, claim 1 is allowable over the combination of Heikes and Danker. Chodor is cited for its alleged teaching of the identifier and location being included in a message. The Office argues that Hickman, or alternatively Dawson, teaches storing an identifier and a location in the header of a message. However, Chodor, Hickman and Dawson each fails to remedy the deficiencies of Heikes and Danker, as noted above with regard to independent claim 1. Therefore, claims 8-10 are also allowable over the cited documents of record for at least their dependency from an allowable base claim, and also for the additional features that each recites. Accordingly, Applicant respectfully requests that the Office withdraw the § 103 rejections of claims 8-10.

Claim 14 recites a method comprising [emphasis added]:

- receiving a communication by a message receiver, wherein the communication includes a character sequence in a text message, wherein the character sequence is mappable to an array grid of pixels residing outside the communication;
- retrieving the array grid of pixels using the character sequence;
- replacing the character sequence within the text message in the communication with the array grid of pixels; and
- displaying the array grid of pixels and the text message on a screen, the array grid of pixels being displayed ***within the text message*** in place of the character sequence.

In making out the rejection of this claim, the Office states that Heikes does not teach “displaying the array grid of pixels and the text message on a screen, the array grid of pixels being displayed within the text message in place of the character sequence.” Applicant agrees. The Office then argues that Danker provides the missing teaching. Applicant respectfully but strongly disagrees.

In support of its argument, the Office cites to Danker's Figure 6B along with paragraphs [0016] and [0075]. The cited textual portions, along with paragraphs [0015], [0017], [0070], and [0071] for context, are reproduced below for the Office's convenience [emphasis added]:

[0015] In addition to displaying language expressions, icons associated with other instant messaging users may be displayed. ***These icons represent the associated user's current status. For instance, the status may indicate whether the user is online and ready to receive instant messages, offline, or online but unavailable to receive instant messages.*** Such icons may change when the status of the associated user changes. When a user changes status, other users receive a command, which changes the display of that user's icon. Status changes may be included as part of an instant message.

[0016] Status changes included as part of an instant message may be caused by a sequence of characters that do not typically occur in written language. When a given sequence of characters is received, instead of displaying the characters on a display, the characters are interpreted as changing the sending user's status. For example, when a user enters text often used to draw a happy face (sometimes referred to as "emoticons"), this character sequence is received and the sending users [sic] icon, which is displayed to the other users, changes to represent that emoticon.

[0017] If a message is not received because a user is offline or unavailable, the complete message may have to be re-entered at a later time. The present invention reduces the likelihood of this occurrence since ***users know when other users are available to engage in an instant messaging session. Preventing a user from having to re-enter a completed instant message reduces the amount of input required by the user.***

[0070] Also ***included in display 400*** are instant messaging users 403, which include all the instant messaging users that may be contacted by the user of display 400. In this case, instant messaging users 403 includes Person1, Person 2, and Person3. An individual user may be selected in a manner similar to selecting a language expression.

[0071] Associated with instant messaging users 403 is icon 401. ***In display 400, icon 401 is used to represent the current state of Person1.*** Person1 may change the appearance of icon 401, and thus their current state, by sending a command to the network device associated with display 400. ***For instance, Person1 may change the appearance***

of icon 401 when going offline or when Person1 is not able to receive instant messages. Commands for changing the appearance of icons, such as icon 401 may be included in instant messages.

[0075] When network device receives [sic] such a character sequence (act 503), a changed status icon is displayed to the first user to represent a change in the second users ***capability to engage in an instant messaging*** [sic] session (act 504). The character sequence may be sent as an individual command or included in an instant message. When the character sequence is included in an instant message, the network device associated with display 400 processes the character sequence to change the icon. In one embodiment, the network device associated with display 400 may ***strip*** the character sequence ***from the instant message*** before ***displaying*** the ***contents of the instant message***.

Applicant has thoroughly reviewed not only the cited portions reproduced above, but also the entire Danker reference and can find no teaching or suggestion of “displaying the array grid of pixels and the text message on a screen, the array grid of pixels being ***displayed within the text message in place of the character sequence.***” As can be appreciated from the excerpts reproduced above, Danker’s icons represent a user’s availability for receiving instant messages. The motivation for Danker’s invention is laid out in paragraph [0017]. The Office appears to equate Danker’s status icons with Applicant’s “array grid of pixels.” The Office also appears to equate Danker’s character sequence with Applicant’s “character sequence.” Applicant will attempt to follow the Office’s logic. Applicant agrees that Danker displays both the icon representing a user’s availability and an instant message on display 400. However, even *following the Office’s logic*, Danker does not display its status icon representing a user’s availability ***within the instant message*** in place of the character sequence. Applicant respectfully submits that, not only does Danker not teach or suggest “the array grid of pixels being ***displayed within the text message*** in place of

the character sequence,” it would make no sense for Danker to do so in the context of its invention.

Referring to Danker’s Figure 4, Danker’s display 400 includes a list of instant messaging users 403, an icon 401 associated with one of the list of instant messaging users (in this case, Person1), an instant message 405, and a text entry area 404. As described by Danker and as seen in Danker’s Figure 4, the status icon 401 for Person1 is not ***within the instant message***. It appears that if Person1 sent a character sequence to change his status icon (although there is no indication that he did), it was stripped out of the instant message before displaying the contents of the instant message (as taught by Danker’s paragraph [0075]).

Or perhaps Person1 didn’t change his status with the illustrated instant message. In that case, the status icon 401 pictured for Person1 *endures* from a previous status icon change. Given Danker’s motivation for its invention, this makes sense. It would seem pointless to make the recipient wait for an instant message from Person1 to realize that Person1 is online and available for instant messaging. And, of course, if Person1 is offline, there would be *no* instant message from Person1 *while he is offline* indicating his status. Furthermore, what if Person1 were to change his status icon to show he is offline and then Person2 were to instant message the recipient? According to the Office’s logic, if Person1’s status icon were included *within* Person1’s instant message, Person1’s status icon would apparently disappear from view along with his instant message while Person2’s message would display as instant message 405 and Person2’s status icon would display as status icon 401. Such a system, where the

status icon is displayed *within* the instant message, would completely defeat the purpose of Danker's status icons.

Applicant respectfully submits that neither Heikes nor Danker discloses or suggests "displaying the array grid of pixels and the text message on a screen, the array grid of pixels being displayed *within the text message* in place of the character sequence." Accordingly, for at least these reasons, this claim is allowable. Applicant respectfully requests that the Office withdraw the § 103 rejection of claim 14.

Claim 17 depends from independent claim 14. Therefore, claim 17 is also allowable over the cited documents of record for at least its dependency from an allowable base claim, and also for the additional features that it recites. Accordingly, Applicant respectfully requests that the Office withdraw the § 103 rejection of claim 17.

Claims 15 and 16 depend from independent claim 14. As discussed above, claim 14 is allowable over the combination of Heikes and Danker. Chodor, Hickman and Dawson are cited for the additional features recited in claims 15 and 16. However, Chodor, Hickman and Dawson each fails to remedy the deficiencies of Heikes and Danker, as noted above with regard to independent claim 14. Therefore, claims 15 and 16 are also allowable over the cited documents of record for at least their dependency from an allowable base claim, and also for the additional features that each recites. Accordingly, Applicant respectfully requests that the Office withdraw the § 103 rejections of claims 15 and 16.

Claim 18 ultimately depends from independent claim 14. As discussed above, claim 14 is allowable over the combination of Heikes and Danker. Goodwin is cited for its alleged teaching of using a local storage medium comprising a cache of temporary

files used by a web browser. However, Goodwin fails to remedy the deficiencies of Heikes and Danker as noted above with regard to independent claim 14. Therefore, claim 18 is also allowable over the cited documents of record for at least its dependency from an allowable base claim, and also for the additional features that it recites. Accordingly, Applicant respectfully requests that the Office withdraw the § 103 rejection of claim 18.

Claims 19 and 20 depend from independent claim 14. As discussed above, claim 14 is allowable over the combination of Heikes and Danker. Goldschneider is cited for its alleged teaching of attempting to establish a direct link with a sender of a communication to retrieve the array grid of pixels from a storage medium associated with the sender if a file is not located in the local storage medium. The Office further argues that Huntington teaches retrieving a file through a server between the sender of a communication and a receiver of the communication if a direct link to a sender cannot be established. However, Goldschneider and Huntington each fails to remedy the deficiencies of Heikes and Danker, as noted above with regard to independent claim 14. Therefore, claims 19 and 20 are also allowable over the cited documents of record for at least their dependency from an allowable base claim, and also for the additional features that each recites. Accordingly, Applicant respectfully requests that the Office withdraw the § 103 rejections of claims 19 and 20.

Claim 21 recites a system comprising [emphasis added]:

- a means for performing real-time communication between a first computing client and a second computing client;
- a means for sending, by a message transmitter, a real-time first communication that includes a character sequence representing graphics data of an emoticon represented by a single array grid of pixels;

- a means for sending the graphics data of the emoticon in a second communication, the second communication being separate from the first communication;
- a means for mapping the character sequence in the real-time first communication with the graphics data from the second communication.

In making out the rejection to this claim, the Office states that “[a]s to claim 21, the claim is rejected for reasons similar to claims 1 and 14 above.” In the previous Office Action (dated November 16, 2009), the Office stated that “[a]s to claim 21, the claim is rejected for reasons similar to claims 1 and 6 above.” Applicant, when responding to the November 16, 2009, Office Action, pointed out that the Office had failed to address the specific claim language of claim 21. The Office continues to do so. And, to add to Applicant’s confusion, the Office now refers to claims 1 and 14, rather than 1 and 6, as being “similar.” Applicant is at a loss as to how to adequately respond to this claim rejection but traverses the rejection nonetheless.

According to MPEP 2143.03 [emphasis added]:

All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The language of claim 21 is quite different from the language of claims 1 and 14, thus Applicant respectfully submits that none of the words in claim 21 have been considered in judging the patentability of claim 21 against the prior art. Applicant *sincerely* wants to advance prosecution of this application, but cannot do so if the Office fails to examine the claim *and explain its reasoning*. Applicant respectfully requests that the Office withdraw the § 103 rejection of claim 21 as Applicant believes this claim is *not* rendered obvious by the combination of Heikes and Danker. If the Office insists on

continuing to reject this claim, Applicant respectfully but ***strongly*** requests the Office to point out ***with particularity*** how the references anticipate or render obvious ***each*** of the elements of this claim.

Claim 22 depends from independent claim 21. As discussed above, claim 21 is allowable over the combination of Heikes and Danker. The Office takes Official Notice that adapting images of various sizes and formats to a pixel array format of predetermined size was well known in the art at the time of the invention. Applicant traverses the taking of Official Notice in this instance. Moreover, the Office's Official Notice fails to remedy the deficiencies of Heikes and Danker, as noted above with regard to independent claim 21. Therefore, claim 22 is also allowable over the cited documents of record for at least its dependency from an allowable base claim, and also for the additional features that it recites. Accordingly, Applicant respectfully requests that the Office withdraw the § 103 rejection of claim 22.

Claim 23 recites a custom emoticon engine having at least a physical component in a computing device, the custom emoticon engine comprising [emphasis added]:

- an image selector configured to create a custom graphical emoticon from a still image, wherein the custom graphical emoticon is representable as a single array grid of pixels;
- a custom emoticon object store configured to store the custom graphical emoticon;
- a character sequence assignor configured to associate a sequence of characters with the custom graphical emoticon, the sequence of characters being input by a user via a user-input device; and
- a transmitter configured to send the character sequence embedded in a text message to a destination, wherein the array grid of pixels ***replaces*** the character sequence ***within the text message*** at the destination as both of the text message and the array grid of pixels are displayed on a screen.

In making out the rejection to this claim, the Office states that “[a]s to claim 23, the claim is rejected for reasons similar to claims 1 and 14 above.” The Office used

similar language in its previous Office Action (dated November 16, 2009). Applicant, when responding to the November 16, 2009, Office Action, pointed out that the Office had failed to address the specific claim language of claim 23. The Office continues to do so. According to MPEP 2143.03 [emphasis added]:

"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Despite this, Applicant will do its best to advance prosecution of this application by responding to the rejection of claim 23 via responding to the arguments the Office provided for the rejections of claims 1 and 14.

In making out the rejection of claim 23, the Office presumably believes that Heikes does not teach that "the array grid of pixels **replaces** the character sequence **within the text message** at the destination as both of the text message and the array grid of pixels are displayed on a screen." If so, Applicant agrees. The Office then presumably argues that Danker provides the missing teaching. If so, Applicant respectfully but strongly disagrees.

In support of its argument in rejecting claim 14, the Office cited to Danker's Figure 6B along with paragraphs [0016] and [0075]. The cited textual portions, along with paragraphs [0015], [0017], [0070] and [0071] for context, were reproduced above in the discussion of claim 14.

Applicant has thoroughly reviewed not only the cited portions reproduced above, but also the entire Danker reference and can find no teaching or suggestion that "the array grid of pixels **replaces** the character sequence **within the text message** at the

destination as both of the text message and the array grid of pixels are displayed on a screen.” As can be appreciated from the excerpts reproduced above, Danker’s icons represent a user’s availability for receiving instant messages. The motivation for Danker’s invention is laid out in paragraph [0017]. Presumably, the Office again equates Danker’s status icons with Applicant’s “array grid of pixels” and Danker’s character sequence with Applicant’s “character sequence.”

Applicant will attempt to follow the Office’s logic. Applicant agrees that in Danker’s invention both the instant message and the icon representing the user’s availability are displayed on a screen. However, even *following the Office’s logic*, Danker’s status icon representing a user’s availability does **not replace** its character sequence ***within the instant message***. Applicant respectfully submits that, not only does Danker not teach or suggest that “the array grid of pixels **replaces** the character sequence ***within the text message*** at the destination as both of the text message and the array grid of pixels are displayed on a screen,” it would make no sense for Danker to do so in the context of its invention. The Office is respectfully referred to Applicant’s discussion of Danker’s Figure 4 above for further details.

Applicant respectfully submits that neither Heikes nor Danker discloses or suggests that “the array grid of pixels **replaces** the character sequence ***within the text message*** at the destination as both of the text message and the array grid of pixels are displayed on a screen.” Accordingly, for at least these reasons, this claim is allowable. Applicant respectfully requests that the Office withdraw the § 103 rejection of claim 23. If Applicant has misunderstood the Office’s position regarding claim 23, Applicant respectfully requests the Office to provide its reasoning for the rejection of this claim.

Claims 24 and 25 depend from independent claim 23. As discussed above, claim 23 is allowable over the cited documents. Therefore, claims 24 and 25 are also allowable over the cited documents of record for at least their dependency from an allowable base claim, and also for the additional features that each recites. Accordingly, Applicant respectfully requests that the Office withdraw the § 103 rejections of claims 24 and 25.

Claims 26, 28 and 29 ultimately depend from independent claim 23. As discussed above, claim 23 is allowable over the combination of Heikes and Danker. Chodor is cited for the additional features recited in claims 26, 28 and 29. However, Chodor fails to remedy the deficiencies of Heikes and Danker, as noted above with regard to independent claim 23. Therefore, claims 26, 28 and 29 are also allowable over the cited documents of record for at least their dependency from an allowable base claim, and also for the additional features that each recites. Accordingly, Applicant respectfully requests that the Office withdraw the § 103 rejection of claims 26, 28 and 29.

Claim 27 ultimately depends from independent claim 23. As discussed above, claim 23 is allowable over the combination of Heikes and Danker. Chodor, Hickman and Dawson are cited for their alleged teaching of the additional features of claim 27. However, Chodor, Hickman and Dawson each fails to remedy the deficiencies of Heikes and Danker, as noted above with regard to independent claim 23. Therefore, claim 27 is also allowable over the cited documents of record for at least its dependency from an allowable base claim, and also for the additional features that it recites. Accordingly, Applicant respectfully requests that the Office withdraw the § 103 rejection of claim 27.

Claim 30 recites a computer readable storage medium containing instructions that are executable by a computer to perform actions comprising [emphasis added]:

- creating a custom graphical emoticon by selecting an image associated with the custom graphical emoticon by a sender;
- representing the image as a single array grid of pixels for the custom graphical emoticon;
- assigning a character sequence to the custom graphical emoticon, wherein the character sequence is assignable by the sender; and
- transmitting a text message by the sender along with the character sequence to a destination to allow for reconstruction of the custom graphical emoticon at the destination, wherein the custom graphical emoticon is substituted ***within the text message*** for the character sequence ***within the text message***, and both the text message and the custom graphical emoticon are to be received in the same dialog.

In making out the rejection to this claim, the Office states that “[a]s to claim 30, the claim is rejected for reasons similar to claims 1, 14 and 24 above.” The Office used similar language in its previous Office Action (dated November 16, 2009). Applicant, when responding to the November 16, 2009, Office Action, pointed out that the Office had failed to address the specific claim language of claim 30. The Office continues to do so. According to MPEP 2143.03 [emphasis added]:

All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Despite this, Applicant will do its best to advance prosecution of this application by responding to the rejection of claim 30 via responding to the arguments the Office provided for the rejections of claims 1 and 14.

In making out the rejection of claim 30, the Office presumably believes that Heikes does not teach “the custom graphical emoticon is substituted ***within the text***

message for the character sequence ***within the text message***, and both the text message and the custom graphical emoticon are to be received in the same dialog.” If so, Applicant agrees. The Office then presumably argues that Danker provides the missing teaching. If so, Applicant respectfully but strongly disagrees.

In support of its argument in rejecting claim 14, the Office cited to Danker’s Figure 6B along with paragraphs [0016] and [0075]. The cited textual portions, along with paragraphs [0015], [0017], [0070] and [0071] for context, were reproduced above in the discussion of claim 14.

Applicant has thoroughly reviewed not only the cited portions reproduced above, but also the entire Danker reference and can find no teaching or suggestion that “the custom graphical emoticon is substituted ***within the text message*** for the character sequence ***within the text message***, and both the text message and the custom graphical emoticon are to be received in the same dialog.” As can be appreciated from the excerpts reproduced above, Danker’s icons represent a user’s availability for receiving instant messages. The motivation for Danker’s invention is laid out in paragraph [0017]. Presumably, the Office equates Danker’s status icons with Applicant’s “custom graphical emoticon” and Danker’s character sequence with Applicant’s “character sequence.”

However, even *following the Office’s logic*, Danker’s status icon representing a user’s availability is ***not*** substituted ***within the instant message*** for the character sequence ***within the instant message***. Applicant respectfully submits that, not only does Danker not teach or suggest that “the custom graphical emoticon is substituted ***within the text message*** for the character sequence ***within the text message***,” it

would make no sense for Danker to do so in the context of its invention. The Office is respectfully referred to Applicant's discussion of Danker's Figure 4 above for further details.

Applicant respectfully submits that neither Heikes nor Danker discloses or suggests that "the custom graphical emoticon is substituted ***within the text message*** for the character sequence ***within the text message***, and both the text message and the custom graphical emoticon are to be received in the same dialog." Accordingly, for at least these reasons, this claim is allowable. Applicant respectfully requests that the Office withdraw the § 103 rejection of claim 30. If Applicant has misunderstood the Office's position regarding claim 30, Applicant respectfully requests the Office to provide its reasoning for the rejection of this claim.

Claims 31, 33, 35 and 36 ultimately depend from independent claim 30. As discussed above, claim 30 is allowable over the cited documents. Therefore, claims 31, 33, 35 and 36 are also allowable over the cited documents of record for at least their dependency from an allowable base claim, and also for the additional features that each recites. Accordingly, Applicant respectfully requests that the Office withdraw the § 103 rejections of claims 31, 33, 35 and 36.

Claim 32 depends from independent claim 30. As discussed above, claim 30 is allowable over the combination of Heikes and Danker. Chodor is cited for the additional features recited in claim 32. However, Chodor fails to remedy the deficiencies of Heikes and Danker, as noted above with regard to independent claim 30. Therefore, claim 32 is also allowable over the cited documents of record for at least its dependency from an

allowable base claim, and also for the additional features that it recites. Accordingly, Applicant respectfully requests that the Office withdraw the § 103 rejection of claim 32.

Claim 34 depends from independent claim 30. As discussed above, claim 30 is allowable over the combination of Heikes and Danker. Chodor, Hickman and Dawson are cited for their alleged teaching of the additional features of claim 34. However, Chodor, Hickman and Dawson each fails to remedy the deficiencies of Heikes and Danker, as noted above with regard to independent claim 30. Therefore, claim 34 is also allowable over the cited documents of record for at least its dependency from an allowable base claim, and also for the additional features that it recites. Accordingly, Applicant respectfully requests that the Office withdraw the § 103 rejection of claim 34.

Claim 37 recites a method for facilitating communication using custom emoticons, the method comprising [emphasis added]:

- creating, by a pixel array generator, an emoticon pixel set by a sender by selecting a single set of pixels, which is a custom emoticon;
- storing the emoticon pixel set in a custom emoticon object store of the sender;
- transferring the emoticon pixel set to a destination from the custom emoticon object store of the sender, wherein the transferring comprises establishing a real-time peer-to-peer link between the sender and the destination to retrieve the emoticon pixel set from the custom emoticon object store of the sender;
- sending instructions to the destination on how to retrieve the emoticon pixel set;
- mapping the character sequence to the emoticon pixel set using a keyboard device;
- parsing the character sequence into an object name for the pixel emoticon set, wherein the object name includes both an identifier and a location of the pixel emoticon set;
- storing the identifier and the location in a header of a text message;
- transmitting, to the destination, the text message by a sender, the text message including the character sequence, which was mapped to the pixel emoticon set, the destination being configured to identify and locate the transferred emoticon pixel set at the destination using the identifier and the location transmitted in the header of the text message, wherein both the text message and the emoticon pixel set are displayed on a screen of the

destination, the emoticon pixel set being substituted at the destination ***within the text message*** for the character sequence mapped to the emoticon pixel set ***within the text message***, the emoticon pixel set being transferred from the sender to the destination separately from the transmission of the text message from the sender to the destination.

In making out the rejection to this claim, the Office states that “[a]s to claim 37, the claim is rejected for reasons similar to claims 1, 5, 8, and 31 above.” The Office used similar language in its previous Office Action (dated November 16, 2009). Applicant, when responding to the November 16, 2009, Office Action, pointed out that the Office had failed to address the specific claim language of claim 37. The Office continues to do so. According to MPEP 2143.03 [emphasis added]:

All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Despite this, Applicant will do its best to advance prosecution of this application by responding to the rejection of claim 37 via responding to the arguments the Office provided for other claim rejections.

In making out the rejection of claim 37, the Office presumably believes that Heikes does not teach “the emoticon pixel set being substituted at the destination ***within the text message*** for the character sequence mapped to the emoticon pixel set ***within the text message***, the emoticon pixel set being transferred from the sender to the destination separately from the transmission of the text message from the sender to the destination.” If so, Applicant agrees. The Office then presumably argues that Danker provides the missing teaching. If so, Applicant respectfully but strongly disagrees.

In support of its argument in rejecting claim 14, the Office cited to Danker's Figure 6B along with paragraphs [0016] and [0075]. The cited textual portions, along with paragraphs [0015], [0017], [0070] and [0071] for context, were reproduced above in the discussion of claim 14.

Applicant has thoroughly reviewed not only the cited portions reproduced above, but also the entire Danker reference and can find no teaching or suggestion of "the emoticon pixel set being substituted at the destination ***within the text message*** for the character sequence mapped to the emoticon pixel set ***within the text message***, the emoticon pixel set being transferred from the sender to the destination separately from the transmission of the text message from the sender to the destination." As can be appreciated from the excerpts reproduced above, Danker's icons represent a user's availability for receiving instant messages. The motivation for Danker's invention is laid out in paragraph [0017]. Presumably, the Office equates Danker's status icons with Applicant's "emoticon pixel set" and Danker's character sequence with Applicant's "character sequence."

However, even following the Office's logic, Danker's status icon representing a user's availability is ***not*** being substituted at the destination ***within the instant message*** for a character sequence mapped to the status icon ***within the instant message***. Applicant respectfully submits that, not only does Danker not teach or suggest "the emoticon pixel set being substituted at the destination ***within the text message*** for the character sequence mapped to the emoticon pixel set ***within the text message***," it would make no sense for Danker to do so in the context of its invention.

The Office is respectfully referred to Applicant's discussion of Danker's Figure 4 above for further details.

Applicant respectfully submits that neither Heikes, Danker, Chodor nor Hickman discloses or suggests "the emoticon pixel set being substituted at the destination **within the text message** for the character sequence mapped to the emoticon pixel set **within the text message**, the emoticon pixel set being transferred from the sender to the destination separately from the transmission of the text message from the sender to the destination." Accordingly, for at least these reasons, this claim is allowable. Applicant respectfully requests that the Office withdraw the § 103 rejection of claim 37. If Applicant has misunderstood the Office's position regarding claim 37, Applicant respectfully requests the Office to provide its reasoning for the rejection of this claim.

As amended, **claim 38** recites a method for facilitating communication using custom emoticons, the method comprising [emphasis added]:

- receiving a communication by a message receiver, wherein the communication comprises:
 - a text message, the text message including a custom-emoticon-mapped character sequence, which is mapped to a custom emoticon pixel set, which is defined as a set of pixels residing outside the communication; and
 - a header storing at least one of an identifier and a location of the custom emoticon pixel set, the identifier and the location comprising at least part of an object name for the custom emoticon pixel set;
- determining whether the custom emoticon pixel set is stored in a local storage medium of the message receiver, wherein the determining utilizes the identifier and the location;
- in response to the determining, retrieving the custom emoticon pixel set from the local storage medium of the message receiver;
- otherwise, retrieving the custom emoticon pixel set from a storage medium associated with the sender of the communication or with a server, in which the communication did not originate;
- displaying the text message in a screen, the custom emoticon pixel set being displayed **in the text message** instead of and in place of the custom-emoticon-mapped character sequence **in the text message**.

In making out the rejection to this claim, the Office states that “[a]s to claim 38, the claim is rejected for reasons similar to claims 1, 15, 17, and 19 above.” The Office used similar language in its previous Office Action (dated November 16, 2009). Applicant, when responding to the November 16, 2009, Office Action, pointed out that the Office had failed to address the specific claim language of claim 38. The Office continues to do so. According to MPEP 2143.03 [emphasis added]:

All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Despite this, Applicant will do its best to advance prosecution of this application by responding to the rejection of claim 38 via responding to the arguments the Office provided for other claim rejections.

In making out the rejection of claim 38, the Office presumably believes that Heikes does not teach “displaying the text message in a screen, the custom emoticon pixel set being displayed ***in the text message*** instead of and in place of the custom-emoticon-mapped character sequence ***in the text message***.” If so, Applicant agrees. The Office then presumably argues that Danker provides the missing teaching. If so, Applicant respectfully but strongly disagrees.

In support of its argument in rejecting claim 14, the Office cited to Danker’s Figure 6B along with paragraphs [0016] and [0075]. The cited textual portions, along with paragraphs [0015], [0017], [0070] and [0071] for context, were reproduced above in the discussion of claim 14.

Applicant has thoroughly reviewed not only the cited portions reproduced above, but also the entire Danker reference and can find no teaching or suggestion of “displaying the text message in a screen, the custom emoticon pixel set being displayed ***in the text message*** instead of and in place of the custom-emoticon-mapped character sequence ***in the text message***.” As can be appreciated from the excerpts reproduced above, Danker’s icons represent a user’s availability for receiving instant messages. The motivation for Danker’s invention is laid out in paragraph [0017]. Presumably, the Office equates Danker’s status icons with Applicant’s “custom emoticon pixel set” and Danker’s character sequence with Applicant’s “custom-emoticon-mapped character sequence.”

However, even following the Office’s logic, Danker’s status icon representing a user’s availability is ***not*** being displayed ***in the instant message*** instead of and in place of the character sequence ***in the instant message***. Applicant respectfully submits that, not only does Danker not teach or suggest “displaying the text message in a screen, the custom emoticon pixel set being displayed ***in the text message*** instead of and in place of the custom-emoticon-mapped character sequence ***in the text message***,” it would make no sense for Danker to do so in the context of its invention. The Office is respectfully referred to Applicant’s discussion of Danker’s Figure 4 above for further details.

Applicant respectfully submits that neither Heikes, Danker, Hickman, Dawson, Goldschneider nor Huntington discloses or suggests “displaying the text message in a screen, the custom emoticon pixel set being displayed ***in the text message*** instead of and in place of the custom-emoticon-mapped character sequence ***in the text***

message..." Accordingly, for at least these reasons, this claim is allowable. Applicant respectfully requests that the Office withdraw the § 103 rejection of claim 38. If Applicant has misunderstood the Office's position regarding claim 38, Applicant respectfully requests the Office to provide its reasoning for the rejection of this claim.

Conclusion

For at least the foregoing reasons, all pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application.

If any issues remain that would prevent allowance of this application, Applicant requests that the Examiner contact the undersigned representative before issuing a subsequent Action.

Respectfully Submitted,

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Representative for Applicant

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